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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,414	11/10/2003	Joseph F. Scalisi	949-01-PA-J	5183

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EXAMINER

NGUYEN, TUAN HOANG

ART UNIT PAPER NUMBER

2643

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,414

Applicant(s)

SCALISI ET AL.

Examiner

Tuan H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell et al. (U.S PAT. 6,373,930 herein "McConnell") in view of Takatori et al. (U.S PUB. 2003/0078844 herein "Takatori").

Regarding claim 1 McConnell discloses a method for providing a wireless telephone service, the method comprising: providing a dedicated programmable wireless telecommunication switch coupled to a public switched telephone network, a voice mail server, and a billing server (col. 13 lines 10-43 and col. 22 lines 24-46); providing a wireless handset having a telephone number associated with it, the handset being capable of telephonic communication with the dedicated switch, and of placing and receiving telephones calls through the switch to and from telephone numbers on a secured list of telephone numbers programmed in the switch (col. 18 lines 15-41). McConnell differs from the claimed invention in not specifically teaching for providing at least two billing accounts associated with the telephone number of the handset, the accounts comprising a secured account having a password and the telephone numbers of the secured list associated with it, and a dependent account having a password associated with it; detecting the telephone number of a caller of an incoming call to the handset, and if none is detected, then prompting the caller to provide a password; detecting the telephone number being called in an outbound call from the handset; debiting the secured account for completed incoming calls to the handset in which the detected number of the caller is on the secured list, or in which the caller provides the password of the secured account, and for completed calls from the handset to telephone numbers on the secured list; and, debiting the dependent account for

completed incoming calls to the handset in which the detected number of the caller is not on the secured list, or in which the caller does not provide the password of the secured account, and for completed outgoing calls from the handset to telephone numbers that are not on the secured list. However, Takatori teaches for providing at least two billing accounts associated with the telephone number of the handset, the accounts comprising a secured account having a password and the telephone numbers of the secured list associated with it, and a dependent account having a password associated with it (page 1 [0010] through [0014]); detecting the telephone number of a caller of an incoming call to the handset, and if none is detected, then prompting the caller to provide a password (page 2 [0028]); detecting the telephone number being called in an outbound call from the handset (page 2 [0029]); debiting the secured account for completed incoming calls to the handset in which the detected number of the caller is on the secured list, or in which the caller provides the password of the secured account, and for completed calls from the handset to telephone numbers on the secured list (page 5 [0084]); and, debiting the dependent account for completed incoming calls to the handset in which the detected number of the caller is not on the secured list, or in which the caller does not provide the password of the secured account, and for completed outgoing calls from the handset to telephone numbers that are not on the secured list (page 7 [0106]). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify McConnell for providing at least two billing accounts associated with the telephone number of the handset, the accounts comprising a secured account having a password

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and the telephone numbers of the secured list associated with it, and a dependent account having a password associated with it; detecting the telephone number of a caller of an incoming call to the handset, and if none is detected, then prompting the caller to provide a password; detecting the telephone number being called in an outbound call from the handset; debiting the secured account for completed incoming calls to the handset in which the detected number of the caller is on the secured list, or in which the caller provides the password of the secured account, and for completed calls from the handset to telephone numbers on the secured list; and, debiting the dependent account for completed incoming calls to the handset in which the detected number of the caller is not on the secured list, or in which the caller does not provide the password of the secured account, and for completed outgoing calls from the handset to telephone numbers that are not on the secured list as per teaching of Takatori, because it provides a portable device at least storing an identifier of a user and outputting billing account information of any billing account of a plurality of billing accounts, and a control server having a storage for storing the identifier of the user and plural pieces of billing account information corresponding to the identifier and a charging for identifying the user by the identifier obtained from the portable device and determining a billing account to which a cost is charged by the billing account information obtained from the portable device.

Regarding claim 2, McConnell further discloses a dependent list of telephone numbers is programmed in the switch, and further comprising: debiting the dependent

account for completed incoming and outgoing calls to and from the handset that are made to and from telephone numbers that are on the dependent list (col. 8 lines 30-47).

Regarding claim 3, McConnell further discloses the handset is capable of making calls only to telephone numbers that are on the secured or the dependent lists (col. 12 lines 34-44).

Regarding claim 4, McConnell further discloses the handset is capable of receiving calls only from telephone numbers that are on the secured or the dependent lists (col. 12 lines 34-44).

Regarding claim 11, McConnell further discloses the user of the handset attempts to make an outgoing call, and wherein credit is not available in either the dependant or the secured accounts, and further comprising: providing the user with an option of adding credit to the dependent or secured accounts by listening to a recorded advertising message (col. 14 line 61 through col. 15 line 12).

Regarding claim 12, McConnell further discloses providing a third billing account associated with the telephone number of the handset, the third account comprising an alert service account and having associated with it a password and an alert service list of telephone numbers programmed in the switch (Fig. 3 col. 5 line 63 through col. 6 line 4); calling the user of the handset at the telephone number thereof at selected times

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and selected intervals (col. 13 lines 56-67); if the user answers the call, playing or displaying a first pre-recorded message to the user of the handset (col. 12 line 57 through col. 13 line 9); prompting the user to acknowledge receipt of the message (col. 12 line 57 through col. 13 line 9); if the user does not answer the call or does not acknowledge receipt of the message within a selected period of time, initiating an escalation process, comprising: repeating the call to the user at selected intervals thereafter (col. 13 lines 56-67); sequentially calling the telephone numbers on the alert service list (col. 19 lines 28-53; if a respondent at one of the numbers on the alert service list answers the call, playing or displaying a second pre-recorded message identifying the user, and stating that the user failed to acknowledge receipt of the first message (col. 12 line 57 through col. 13 line 9); prompting the respondent to acknowledge receipt of the second message (col. 12 line 57 through col. 13 line 9); and, continuously repeating the preceding steps until receipt of the first or the second message is acknowledged (col. 21 lines 53-64).

Regarding claim 13, McConnell further discloses the first message comprises a reminder to take or administer medications (col. 2 lines 44-52).

Regarding claim 14, Takatori further discloses the dedicated switch is further coupled to the internet, and further comprising: providing an interactive web page on the internet through which a customer or a customer's representative can obtain information regarding the customer's account and program selected features of the dedicated



switch that relate to the customer's account (page 5 [0086]); logging the customer or customer's representative onto the web page (page 1 [0005]); prompting the customer or customer's representative for the telephone number of the handset (page 2 [0027]); if the customer or customer's representative provides the telephone number of the handset, prompting the customer or customer's representative for the password of the secured account or the dependent account (page 2 [0028]); and, if the customer or customer's representative provides the password of the secured account or the dependent account, providing the customer or customer's representative with the status of the secured account or the dependent account and enabling the customer or customer's representative to modify the secured list of telephone numbers online (page 2 [0028]).

Regarding claim 15, Takatori further discloses the dedicated switch is further coupled to the internet, and further comprising: providing an interactive web page on the internet through which a customer or a customer's representative can obtain information regarding the customer's account and program selected features of the dedicated switch that relate to the customer's account (page 5 [0086]); logging the customer or customer's representative onto the web page (page 1 [0005]); prompting the customer or customer's representative for the telephone number of the handset (page 2 [0027]); if the customer or customer's representative provides the telephone number of the handset, prompting the customer or customer's representative for the password of the secured account or the dependent account (page 2 [0028]); and, if the customer or

customer's representative provides the password of the secured account or the dependent account, providing the customer or customer's representative with the status of the secured account or the dependent account and enabling the customer to modify the secured list or the dependent list of telephone numbers online (page 2 [0028]).

Regarding claim 16, Takatori further discloses the dedicated switch is further coupled to the internet, and further comprising: providing an interactive web page on the internet through which a customer or a customer's representative can obtain information regarding the customer's account and program selected features of the dedicated switch that relate to the customer's account (page 5 [0086]); logging the customer or customer's representative onto the web page (page 1 [0005]); prompting the customer or customer's representative for the telephone number of the handset (page 2 [0027]); if the customer or customer's representative provides the telephone number of the handset, prompting the customer for the password of the alert service account (page 2 [0028]); and, if the customer provides the password of the alert service account, providing the customer with the status of the alert service account and enabling the customer to modify the times and intervals of the calls to the handset user, the message played or displayed to the user, the selected intervals at which repeat calls to the user are made, and the telephone numbers of the alert service list online (page 2 [0027] and [0028]).

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4. Claims 5-10 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell et al. (U.S PAT. 6,373,930 herein "McConnell") in view of Takatori et al. (U.S PUB. 2003/0078844 herein "Takatori") as applied to claims above, and further in view of Fougnyes et al. (U.S PAT. 6,157,823 herein "Fougnyes").

Regarding claim 5, McConnell and Takatori, in combination, fails to disclose the telephone number of an incoming caller corresponds to a number on the secured list, or the caller provides the secured account password, and further comprising: determining whether credit is available in the secured account; if credit is not available in the secured account, providing the caller with an option of recording a voice mail to the handset user on the voice mail server; if credit is available in the secured account, determining whether the user is available to take the call; if the user is not available to take the call, providing the caller with an option of recording a voice mail to the user on the mail server; if the user is available to take the call, connecting the call to the handset; metering the length of the call; and, debiting the secured account for the call. However, Fougny teaches the telephone number of an incoming caller corresponds to a number on the secured list, or the caller provides the secured account password, and further comprising: determining whether credit is available in the secured account (Fig. 2 col. 6 lines 11-43); if credit is not available in the secured account, providing the caller with an option of recording a voice mail to the handset user on the voice mail server (Fig. 2 col. 6 lines 41-55); if credit is available in the secured account, determining whether the user is available to take the call (col. 6 lines 34-41); if the user is not available to take the call, providing the caller with an option of recording a voice mail to the user on the mail server (Fig. 2 col. 6 lines 41-55); if the user is available to take the call, connecting the call to the handset (col. 10 lines 11-21); metering the length of the call (col. 6 lines 44-55); and, debiting the secured account for the call (col. 9 lines 16-28). Therefore, it is obvious to one of ordinary skill in the art at the time the invention

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was made to incorporate the disclosing of Fougnyes into view of McConnell and Takatori, in order to recognize for a cellular telecommunications system which permits access by pre-paid users, without the need for modifying the cellular radiotelephones commonly in use.

Regarding claim 6, McConnell further discloses credit is not available in the secured account, and further comprising: providing the caller with an alternative option of adding credit to the secured account by listening to a recorded advertising message (col. 14 line 61 through col. 15 line 12).

Regarding claim 7, Fougnyes further discloses the caller leaves a voice mail to the user on the voice mail server, and wherein the dedicated switch is further coupled to the internet, and further comprising: recording the voice mail as or converting it to a sound file (col. 6 lines 11-55); and, transmitting the sound file to an e-mail address of the user (col. 6 lines 11-55).

Regarding claim 8, Fougnyes further discloses the telephone number of an incoming caller corresponds to a number of the dependent list, and further comprising: determining whether credit is available in the dependent account (col. 6 lines 11-43); if credit is not available in the dependent account, providing the caller with an option of recording a voice mail to the handset user on the voice mail server (Fig. 2 col. 6 lines 41-55); if credit is available in the dependent account, determining whether the user is available to take the call (col. 6 lines 34-41); if the user is not available to take the call, providing the caller with an option of recording a voice mail to the user on the voice mail server (col. 6 lines 41-55); if the user is available to take the call, connecting the call to the handset (col. 10 lines 11-21); metering the length of the call (col. 6 lines 44-55); and, debiting the dependent account for the call (col. 9 lines 16-28).

Regarding claim 9, Fougnyes further discloses the caller leaves a voice mail to the user on the voice mail server, and wherein the dedicated switch is further coupled to the internet, and further comprising: recording the voice mail as or converting it to a sound file; and, transmitting the sound file to an e-mail address of the user (col. 6 lines 11-55).

Regarding claim 10, McConnell further credit is not available in the dependent account, and further comprising: providing the caller with an alternative option of adding credit in the dependent account by listening to a recorded advertising message (col. 14 line 61 through col. 15 line 12).

Regarding claim 17, Fournies further discloses at least one of the telephone numbers of the secured list includes a home location telephone number provided by a fixed wire telephone provider, and further comprising: determining whether the telephone number of the caller of an incoming call to the handset corresponds to a telephone number of the secured list (Fig. 2 col. 6 lines 11-43); if the telephone number of the caller corresponds to a telephone number of the secured list, connecting the call to the handset (col. 10 lines 11-21); metering the length of the call (col. 6 lines 44-55); and, charging the cost of the call to the home location number through the fixed wire provider (col. 9 lines 16-28).

Regarding claim 18, Fournies further discloses providing the caller with an option of charging the cost of the call to the home location number through the fixed wire provider (col. 5 line 57 through col. 6 line 10).

Regarding claim 19, Fournies further discloses prompting the caller for the secured account password (col. 1 lines 11-21).

Regarding claim 20, Fournies further discloses at least one of the telephone numbers of the secured list includes a home location telephone number provided by a fixed wire telephone provider, and further comprising: determining whether a telephone number being called by the handset corresponds to a number on the secured list (Fig. 2 col. 6 lines 11-43); if the telephone number being called corresponds to a telephone number of the secured list, connecting the call (col. 10 lines 11-21); metering the length of the call (col. 6 lines 44-55); and, charging the cost of the call to the home location number through the fixed wire provider (col. 9 lines 16-28).

Regarding claim 21, Fournies further discloses providing the caller with an option of charging the cost of the call to the home location number through the fixed wire provider (col. 5 line 57 through col. 6 line 10).

Regarding claim 22, Fournies further discloses prompting the user for the dependent account password (col. 3 lines 3-8).

### ***Conclusion***

5. Any response to this action should be mailed to:

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Commissioner for Patents

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571) 272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Tuan Nguyen

Examiner

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